

PATENT  
Atty. Dkt. No. ROC920010308US1  
MPS Ref. No.: IBMK10308

## REMARKS

This is intended as a full and complete response to the Office Action dated February 25, 2005 having a shortened statutory period for response set to expire on May 25, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-28 are pending in the application. Claims 1-28 remain pending following entry of this response. Claims 1-5, 6-14, 16-23 and 25-28 have been amended. Applicants submit that the amendments and new claims do not introduce new matter.

### Claim Rejections - 35 U.S.C. § 112

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have amended independent claims 1, 11, and 20 to clarify what is claimed. Claims 2-10, 12-19, and 21-28 are also clarified for dependency upon claims 1, 11, and 20. Claims 1-28 are now believed to be in condition for allowance.

### Claim Rejections - 35 U.S.C. § 102

Claims 1-28 stand rejected under 35 U.S.C. 102(e) as being anticipated by *Bates et al.* (US Pub. 2003/0061599) hereinafter referred to as "Bates." Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, ... *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Bates* does not disclose "each and every element as set forth in the claim".

*Bates* teaches a method of "tracking breakpoint hits in a program being

PATENT  
Atty. Dkt. No. ROC920010308US1  
MPS Ref. No.: IBMK10308

debugged", paragraph 0002. Paragraph 0050 describes process 500 in Fig. 5C, which is evoked by a breakpoint hit event as shown in Fig. 5A, step 532. If step 534 is answered negatively, or step 534 is true and step 536 is true, the breakpoint is encountered and fired. Therefore, halting the execution upon exiting the region without firing a breakpoint is the region is not taught.

Therefore, *Bates*, at minimum, does not determine whether the execution of code exits a region of the code without firing a user-specified breakpoint and, if so, halt the execution of the code. Thus, claims 1, 11, and 20 are believed to be in condition of allowance. Claims 2-10, 12-19, and 21-28 are also in condition for allowance in that these claims depend from claims 1, 11, and 20.

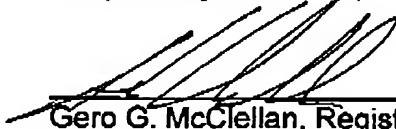
The under-signed attorney had a telephonic interview with the Examiner and the Examiner's supervisor on May 5, 2005. The amendments presented herein are believed to be consistent with the agreement reached during the interview.

Conclusion

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



Gero G. McClellan, Registration No. 44,227  
MOSER, PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicants

Page 9

358266\_2